

PTO/SB/21 (09-04)

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|---|----------------------|---------------------------|------------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | Application Number | 10/559,405 | |
| | Filing Date | June 4, 2004 | |
| | First Named Inventor | PATTERSON, John W. et al. | |
| | Art Unit | | |
| | Examiner Name | | |
| Total Number of Pages in This Submission | 7 | Attorney Docket Number | 53515AUSM1 |

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| ENCLOSURES (Check all that apply) | | |
|---|--|--|
| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD | <input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Attorney Letter (1 page) Copy of Filing Receipt (3 pgs) Copy of Declaration (2 pgs) |
| Remarks | | |

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

| | | | |
|--------------|-----------------------------|----------|--------|
| Firm Name | BERLEX BIOSCIENCES | | |
| Signature | <i>Jacqueline S. Larson</i> | | |
| Printed name | JACQUELINE S. LARSON | | |
| Date | Nov. 27, 2006 | Reg. No. | 30,279 |

CERTIFICATE OF TRANSMISSION/MAILING

| | | | |
|---|------------------------|------|---------------|
| I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below: | | | |
| Signature | <i>Mary Ann Flores</i> | | |
| Typed or printed name | MARY ANN FLORES | Date | Nov. 27, 2006 |

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

Docket: 53515AUSM1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | | |
|-----------------------|---|--|-----------------|---------------|
| First Named Inventor: | PATTERSON et al. | RECEIVED CENTRAL FAX CENTER NOV 27 2006 | | |
| Appln. No.: | 10/559,405 | | | |
| Filing/371 Date: | June 26, 2006 | | Examiner: | Not yet known |
| Int'l Filing Date: | June 04, 2004 | | Group Art Unit: | Not yet known |
| Title: | Amidino Compounds as Cysteine Protease Inhibitors | | | |

CORRECTIVE FILING RECEIPT

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Applicants wish to bring to the attention of the USPTO an error made by the USPTO on the enclosed Filing Receipt for the above-identified application. Only one (1) inventor, John Patterson, was listed on the enclosed Filing Receipt, however, there are a total of two (2) inventors as shown on the initial Declaration hercin enclosed. Applicants respectfully request that the USPTO add the following omitted inventor:

Soon H. Woo
3150 Greer Road
Palo Alto, California 94303
Citizenship: Canada

Applicants respectfully request an Updated Filing Receipt reflecting the omitted inventor, Soon H. Woo. Enclosed is the Filing Receipt with the requested correction noted.

Since the error was made on the part of the USPTO, we believe no fee is due, however, the Commissioner is hereby authorized to charge deposit account 02-2114 for any insufficiencies but this is not authorization to charge the issue fee.

Respectfully submitted,

BERLEX INC.
Customer Number 27586

Jacqueline S. Larson
Jacqueline S. Larson, Reg. No. 30,279
Senior Patent Attorney for Applicants

Date: NOV. 27, 2006

Corporate Patents
2600 Hilltop Drive
Richmond, California 94806
(510) 262-5000

53515A
015058-005010US
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P.O. Box 1450
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| APPL NO. | FILING OR 371 (c) DATE | ART UNIT | FIL FEE REC'D | ATTY. DOCKET NO | DRAWINGS | TOT CLMS | IND CLMS |
|------------|---------------------------|----------|---------------|-----------------|----------|----------|----------|
| 10/559,405 | 06/26/2006 | 1614 | 1790 | CL001471 PCT-US | | 20 | 1 |

CONFIRMATION NO. 7243

20350

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834TOWNSEND AND TOWNSEND
& CREW

FILING RECEIPT



OC000000020097016

SEP 05 2006

Date Mailed: 08/18/2006

Receipt is acknowledged of this regular Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. If an error is noted on this Filing Receipt, please mail to the Commissioner for Patents P.O. Box 1450 Alexandria Va 22313-1450. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the USPTO processes the reply to the Notice, the USPTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).

Applicant(s)

John W. Patterson, Mountain View, CA;

Soon H. WOO, Palo Alto, CA ← PLS. ADD

Power of Attorney: The patent practitioners associated with Customer Number 23519.

Domestic Priority data as claimed by applicant

This application is a 371 of PCT/US04/17654 06/04/2004
which claims benefit of 60/475,612 06/04/2003

Foreign Applications

If Required, Foreign Filing License Granted: 08/17/2006

The country code and number of your priority application, to be used for filing abroad under the Paris Convention, is US10/559,405

Projected Publication Date: 11/23/2006

Non-Publication Request: No

Early Publication Request: No

Title

Amidino compounds as cysteine protease inhibitors

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Preliminary Class

514

PROTECTING YOUR INVENTION OUTSIDE THE UNITED STATES

Since the rights granted by a U.S. patent extend only throughout the territory of the United States and have no effect in a foreign country, an inventor who wishes patent protection in another country must apply for a patent in a specific country or in regional patent offices. Applicants may wish to consider the filing of an international application under the Patent Cooperation Treaty (PCT). An international (PCT) application generally has the same effect as a regular national patent application in each PCT-member country. The PCT process **simplifies** the filing of patent applications on the same invention in member countries, but **does not** result in a grant of "an international patent" and does not eliminate the need of applicants to file additional documents and fees in countries where patent protection is desired.

Almost every country has its own patent law, and a person desiring a patent in a particular country must make an application for patent in that country in accordance with its particular laws. Since the laws of many countries differ in various respects from the patent law of the United States, applicants are advised to seek guidance from specific foreign countries to ensure that patent rights are not lost prematurely.

Applicants also are advised that in the case of inventions made in the United States, the Director of the USPTO must issue a license before applicants can apply for a patent in a foreign country. The filing of a U.S. patent application serves as a request for a foreign filing license. The application's filing receipt contains further information and guidance as to the status of applicant's license for foreign filing.

Applicants may wish to consult the USPTO booklet, "General Information Concerning Patents" (specifically, the section entitled "Treaties and Foreign Patents") for more information on timeframes and deadlines for filing foreign patent applications. The guide is available either by contacting the USPTO Contact Center at 800-786-9199, or it can be viewed on the USPTO website at <http://www.uspto.gov/web/offices/pac/doc/general/index.html>.

For information on preventing theft of your intellectual property (patents, trademarks and copyrights), you may wish to consult the U.S. Government website, <http://www.stopfakes.gov>. Part of a Department of Commerce initiative, this website includes self-help "toolkits" giving innovators guidance on how to protect intellectual property in specific countries such as China, Korea and Mexico. For questions regarding patent enforcement issues, applicants may call the U.S. Government hotline at 1-866-999-HALT (1-866-999-4158).

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The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 37 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Bureau of Industry and Security, Department of Commerce (15 CFR parts 730-774); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15(b).

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Attorney Docket No.: 015058-005010US
Client Ref. No.: CL001471 PCT-USRECEIVED
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NOV 27 2006

PTO/SB/01A 10-05)

DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76)

| | |
|-----------------------|---|
| Title of Invention | AMIDINO COMPOUNDS AS CYSTEINE PROTEASE INHIBITORS |
|-----------------------|---|

As the below named inventor(s), I/we declare that:

This declaration is directed to:

☐ The attached application, or

☒ Application No. 10/559,405 filed on December 5, 2005
Int'l Application No.: PCT/US04/17654 International Filing Date: June 4, 2004

☐ as amended on _____ (if applicable);

I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;

I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.

WARNING:

Petitioner/applicant is cautioned to avoid submitting personal information in documents filed in a patent application that may contribute to identity theft. Personal information such as social security numbers, bank account numbers, or credit card numbers (other than a check or credit card authorization form PTO-2038 submitted for payment purposes) is never required by the USPTO to support a petition or an application. If this type of personal information is included in documents submitted to the USPTO, petitioners/applicants should consider redacting such personal information from the documents before submitting them to the USPTO. Petitioner/applicant is advised that the record of a patent application is available to the public after publication of the application (unless a non-publication request in compliance with 37 CFR 1.213(a) is made in the application) or issuance of a patent. Furthermore, the record from an abandoned application may also be available to the public if the application is referenced in a published application or an issued patent (see 37 CFR 1.14). Checks and credit card authorization forms PTO-2038 submitted for payment purposes are not retained in the application file and therefore are not publicly available.

All statements made herein of my/our own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

| | |
|--|----------------------------------|
| FULL NAME OF INVENTOR(S) | |
| Inventor one: <u>John W. Patterson</u> | Citizen of: <u>United States</u> |
| Signature: <u>John W. Patterson</u> | Date: <u>June 8, 2006</u> |
| Inventor two: <u>Soon H. Woo</u> | Citizen of: <u>Canada</u> |
| Signature: _____ | Date: _____ |
| <input type="checkbox"/> Additional inventors or a legal representative are being named on _____ additional form(s) attached hereto. | |

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NOV 27 2006

Attorney Docket No.: 015058-005010US
Client Ref. No.: CL001471 PCT-US

PTO/SB/01A 10-05)

DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION USING AN
APPLICATION DATA SHEET (37 CFR 1.76)Title of
Invention

AMIDINO COMPOUNDS AS CYSTEINE PROTEASE INHIBITORS

As the below named inventor(s), I/we declare that:

This declaration is directed to:

- ☐ The attached application, or
- ☒ Application No. 10/559,405 filed on December 5, 2005
Int'l Application No.: PCT/US04/17654 International Filing Date: June 4, 2004
- ☐ as amended on _____ (if applicable);

I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;

I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT International filing date of the continuation-in-part application.

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All statements made herein of my/our own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that wilful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

FULL NAME OF INVENTOR(S)

Inventor one: John W. PattersonCitizen of: United States

Signature: _____

Date: _____

Inventor two: Soon H. WooCitizen of: CanadaSignature: Soon H. WooDate: May 27, 2006

☐ Additional inventors or a legal representative are being named on _____ additional form(s) attached hereto.